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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/533,090   | 04/29/2005  | Norikazu Tabata      | IPE-055                       | 2293                   |
| 7590<br>Kubovcik & Kubovcik<br>The Farragut Building<br>Suite 710<br>900 17th Street, N.W.<br>Washington, DC 20006 | 09/24/2007  |                      | EXAMINER<br>DICKINSON, PAUL W |                        |
|  |             |                      | ART UNIT<br>1609              | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/24/2007       | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                               |                  |
|------------------------------|-------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)     |
|                              | 10/533,090                    | TABATA ET AL.    |
|                              | Examiner<br>Paul W. Dickinson | Art Unit<br>1609 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-44 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| <ol style="list-style-type: none"> <li>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date ____.</li> </ol> | <ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. ____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application</li> <li>6)<input type="checkbox"/> Other: ____.</li> </ol> |
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## DETAILED ACTION

### ***Restriction***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:

Group I, claim(s) 1-10, 34-35, 37, 40 drawn to an embolization material.

Group II, claim(s) 11-18, 38 drawn to an embolization material.

Group III, claim(s) 19-33, 39 drawn to an embolization material.

Group IV, claim(s) 36, 41, 44 drawn to an embolization method.

Group V, claim(s) 42, drawn to an embolization method.

Group VI, claim(s) 43, drawn to an embolization method.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The special technical feature of Groups I is an embolization material having a water-swelling ratio of 30% and being degradable in a phosphate buffered saline of 37°C. The special technical feature of Group II is an embolization material which is composed of a water-insoluble polymer having a tensile modulus of elasticity of a film of 1500 Mpa or less. The special technical feature of Group III is an embolization material

which contains a water-insoluble polyethylene glycol copolymer. Each method of Groups IV, V, and VI are drawn to injecting a solution containing the embolization material from Groups I, II, and III, respectively. Therefore, each method has a different special technical feature from each other. In addition, each method (Groups IV, V, VI) has a different special technical feature from the corresponding embolization material (Groups I, II, III). The special technical feature for each method include not only the corresponding embolization material, but also the process for selecting the site where embolization is to take place.

Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have a single general inventive concept and so lack unity of invention.

***Inventorship Notice***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul W. Dickinson whose telephone number is 571-270-3499. The examiner can normally be reached on Mon-Thur 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul W. Dickinson  
Examiner  
Art Unit 1609

September 17, 2007

*Ardin H. Marschel 9/19/07*  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER